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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/023,672	02/13/1998	EDWARD M. SCHEIDT	STS-119	7278

7590 12/29/2003  
IP STRATEGIES, P.C.  
806 7TH STREET, N.W.  
SUITE 301  
WASHINGTON, DC 20001

EXAMINER

DARROW, JUSTIN T

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/29/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/023,672

Applicant(s)

SCHEIDT ET AL.

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

1. Claims 1-69 have been examined.

#### ***Priority***

2. Acknowledgment is made that the instant application claims the benefit of provisional Application No. 60/039,696, filed 02/13/1997.

#### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings must be made in reply to this Office action. See 37 CFR 1.85(a).

#### ***Response to Arguments***

3. In view of the appeal brief filed on 02/14/2001, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise the following option:

file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final).

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8, 32-34, 35-42, and 66-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-8, 32-34, 37-42, and 67-69, respectively, of copending Application No. 09/874,364. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1 and 9-17; 32-34; 35 and 43-51; and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9-16; 31-33; 34 and 42-49; and 64-67, respectively, of U.S. Patent No. 6,542,608 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

7. Claims 1 and 18-24; 32-34; 35 and 52-58; and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7; 15-17; 18-24; and 32-35, respectively, of U.S. Patent No. 6,608,901 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

8. Claims 1 and 25-31; 32-34; 35 and 59-65; and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8; 31-

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33; 34-41; and 64-67, respectively, of U.S. Patent No. 6,549,623 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

***Allowable Subject Matter***

1. Claims 1-8, 32-34, 35-42, and 66-69 would be allowable by terminal disclaimer to overcome the nonstatutory double patenting rejection with respect to any patent issuing from Application No. 09/874,364, set forth in this Office action.

9. Claims 1 and 9-17; 32-34; 35 and 43-51; and 66-69 would be allowable by terminal disclaimer to overcome the nonstatutory double patenting rejection with respect to U.S. Patent No. 6,542,608 B2, set forth in this Office action.

10. Claims 1 and 18-24; 32-34; 35 and 52-58; and 66-69 would be allowable by terminal disclaimer to overcome the nonstatutory double patenting rejection with respect to U.S. Patent No. 6,608,901 B2, set forth in this Office action.

11. Claims 1 and 25-31; 32-34; 35 and 59-65; and 66-69 would be allowable by terminal disclaimer to overcome the nonstatutory double patenting rejection with respect to U.S. Patent No. 6,549,623 B1, set forth in this Office action.

***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

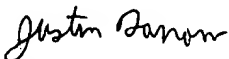
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

December 22, 2003

  
**JUSTIN T. DARROW**  
**PRIMARY EXAMINER**  
**TECHNOLOGY CENTER 2100**